



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nakajima et al.

Serial No.: 10/733,142

Filed: 2/9/2004

Title: WEATHER STRIP

Atty. Dkt.: 26GT-004-DIV2

Art Unit: 3634

Examiner: Gregory J. STRIMBU

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Window  
Randolph Building  
401 Dulany St.  
Alexandria, VA 22314

Date: 22 February 2005

**RESPONSE TO RESTRICTION/ELECTION REQUIREMENT**

Sir:

In response to the election requirement mailed 26 January 2005 in the above-identified application, Applicants respond as follows.

**PROVISIONAL ELECTION**

Applicants hereby provisionally elect, with traverse, the Species in Group I (Figs. 1 – 5), with Figs. 23 and 30 being generic to all species. Applicants state that claims 34, 37 and 38 are readable on the Species in Group I.

**TRAVERSE**

The election requirement is respectfully traversed, because the requirement is improper and does not comply with the criteria for a restriction or an election of species, as specified in 35 USC 121, 37 CFR 1.141-146, and MPEP 801-818.

MPEP 803 specifies that restriction/election between two groups of claims is only proper when (1) the inventions are independent or distinct as claimed and (2) a "serious burden" exists on the examiner in examining the groups of claims. The restriction/election of species requirement does not show either that the groups meet the independent or distinct criteria specified in the MPEP or that there is a "serious burden" in examining the groups of claims in the same application. In fact, it appears that the examiner did not consider the claims currently pending in the application.

The examiner requires restriction and provides reasons therefore, but the reasons are not commensurate with the claims and are not based upon application of the criteria specified in MPEP 806, respecting election of species and restriction requirements. The reasons for request election of species rely upon assertions that are incorrect and analysis that is flawed.

The office action erroneously indicates that claims 1 – 33 are pending. To the contrary, claims 34 – 38 are pending.

The office action states that "no claims are generic." To the contrary, independent claim 34 is generic, and claims 35 – 38 are dependent from claim 34 and include all the limitations of claim 34.

Claim 34 is directed at least in part to the reinforcing portion, illustrated for example in Figs. 1 – 3, 5, 6, 9, 19 and 26 – 29. The reinforcing portion is described as the rib 31 in Figs. 1 –

3, 5, 6, 9 and 29 and as the recovery preventing portion 123 in Figs. 26 – 29. There is no disclosure of the reinforcing portion in the other figures.

The office action identified Groups I – X as the patentably distinct species of the claimed invention. However, the proposed grouping includes figures that are irrelevant to the pending claims.

The following groups of figures are irrelevant to the pending claims because they do not include the claimed reinforcing portion: Fig. 7 (in Group III), Fig. 8 (in Group IV), Figs. 10 – 13 (in Group V), Figs. 14 – 17 (in Group VI), Fig. 18 (in group VII) and Figs. 20 – 22 (in Group VIII). Therefore, the statement in the office action that the application includes claims directed to Groups III – VIII is erroneous.

The applicants propose the following species of the claimed invention, with respect to the pending claims:

Group I      Figures 1 – 3, 5, 6, 9 and 19. Claims 34, 37 and 38.

Group II      Figures 26 – 29.                      Claims 34, 35, 36.

For Group I, the reinforcing portion is described as the rib 31. For Group II, the reinforcing portion is described as the recovery preventing portion 123.

Further, the applicants respectfully indicate that claim 34 is generic.

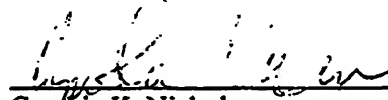
The applicants respectfully request election the species of Group I, Figs. 1 – 3, 5, 6, 9 and 19.

For the reasons given above, the examiner is respectfully requested to reconsider and withdraw or revise the election of species requirement.

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Examination of the present application in view of the above election is respectfully requested. Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

  
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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

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First Named Inventor

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Art Unit

3634

Examiner Name

Gregory J. STRIMBU

Attorney Docket Number

26GT-004-DIV2

**ENCLOSURES (Check all that apply)**

☐ Fee Transmittal Form

☐ Fee Attached

☒ Amendment / Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Reply to Missing Parts/  
Incomplete Application

☐ Reply to Missing Parts under  
37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a  
Provisional Application

☐ Power of Attorney, Revocation  
Change of Correspondence Address

☐ Terminal Disclaimer

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☐ Landscape Table on CD

☐ After Allowance communication to (TC)

☐ Appeal Communication to Board of  
Appeals and Interferences

☐ Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☐ Other Enclosure(s) (please identify  
below):

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

Posz & Bethards, PLC

Signature

Printed name

Cynthia K. Nicholson

Date

22 February 2005

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Cynthia K. Nicholson

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22 February 2005